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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 13
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Aqua Day Spa, L.L.C.

v.

Beauty Emporium, Inc.

Opposition No. 116,582
to application Serial No. 75/665,164
filed on March 22, 1999

Robert T. Egan of Archer & Greiner, P.C. for Aqua Day
Spa, L.L.C.

John M. Cone of Akin, Gump, Strauss, Hauer & Feld, L.L.P.
for Beauty Emporium, Inc.

Before Chapman, Bucher and Holtzman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Beauty Emporium, Inc. has filed an application to
register the mark AQUA on the Principal Register for
"health spa and beauty salon services" in International
Class 42.¹

Aqua Day Spa, L.L.C. has opposed registration of the
mark alleging that opposer is presently constructing a

¹ Application Serial No. 75/665,164, filed March 22, 1999, based
on applicant's assertion of a bona fide intention to use the
mark in commerce.

health spa in southern California and has advertised the business under the mark AQUA DAY SPA; that opposer is considering expanding to other geographic locations; and that applicant's mark, AQUA, is merely descriptive of applicant's health spa services "in that it informs the purchasing public of characteristics of a health spa."

(Paragraph 4.)

Applicant denies the salient allegations of the notice of opposition.

Neither party took any testimony or submitted any notices of reliance. However, on December 29, 2000 the parties filed a stipulation signed by both parties' attorneys which was offered in lieu of taking testimony, and specifically waived any required notices of reliance. The parties' stipulation includes the following evidence: (i) opposer's answers to applicant's interrogatories, and any exhibits thereto, (excluding opposer's answers to applicant's interrogatory Nos. 11 and 12); (ii) applicant's responses to opposer's interrogatories, and any exhibits thereto; (iii) opposer's answers to applicant's document requests, along with the documents produced pursuant thereto; (iv) applicant's responses to opposer's document requests, along with the documents

produced pursuant thereto; and (v) dictionary definitions of the words "aqua" and "spa." Thus, the record consists of the pleadings²; the file of the opposed application; and the above-mentioned stipulation.

Both parties filed briefs on the case. An oral hearing was not requested.

Opposer began advertising its services under its name AQUA DAY SPA on or around June 1, 1999; and opposer opened a day spa under the name AQUA DAY SPA in Santa Monica, California on February 7, 2000. Some of the services offered at opposer's day spa include facials, massages, mineral baths, manicures, pedicures and body scrubs. Opposer has continuously operated its day spa since February 2000.

Since June 1999 applicant has continuously operated a health spa and beauty salon in University Park, Texas (near Dallas) under the name AQUA SPA AT UNIVERSITY PARK (shown on applicant's brochure in special form). Some of the services offered at applicant's health spa and beauty

² After the close of all trial periods, opposer filed (on April 19, 2001) a motion pursuant to Fed. R. Civ. P. 15(b) to amend its notice of opposition to include an alternative claim, namely, that if the term AQUA is not merely descriptive of applicant's health spa services, then it is deceptively misdescriptive thereof. Applicant did not contest the motion to amend, and argued the merits of the misdescriptiveness issue in its brief on the case. We conclude that this issue was tried by

salon include facials, massages, manicures, pedicures, waxing and hair cuts, hair coloring and perms.

The record establishes opposer's standing to bring this opposition. Thus, the only issues before the Board are whether the term AQUA is either merely descriptive or deceptively misdescriptive of "health spa and beauty salon services."

Opposer's argument is summarized on page 18 of its brief as follows:

Either Applicant uses water in connection with its spa services, or it does not. If it does, then its mark, AQUA, meaning water, is unregistrable because it is descriptive of those services. If it does not, then the mark is unregistrable because it is deceptively misdescriptive, given the extensive use of water by other spa owners in the industry.

Opposer specifically contends that according to the dictionary "aqua" is defined as "water," and there is evidence establishing that "aqua" (or water) is a significant component of applicant's health spa and beauty salon services, making the term merely descriptive of said services. Alternatively, opposer contends that there is evidence that the term "aqua" (or water) is prevalent in the spa industry generally, thereby strongly

implied consent of the parties. Accordingly, opposer's motion

suggesting that the average consumer associates spas with "aqua" (or water), and that to the extent the term is not merely descriptive, it is deceptively misdescriptive because it then conveys a falsehood about applicant's services.

Applicant contends that there is a second, well known meaning of the term "aqua," namely that it is a color; that the multi-step reasoning used by opposer shows that the mark is suggestive, not merely descriptive of its services; that opposer's argument "no doubt then, the average consumer considers the word 'aqua' to be descriptive of the word 'spa' generally" (opposer's brief, p. 5) is completely without evidentiary support; that many of the uses of the word "aqua" appear to be trademarks; and that because the word "aqua" is not merely descriptive of applicant's services, it cannot misdescribe the services either.

A term is considered merely descriptive, and therefore unregistrable pursuant to Section 2(e)(1), if it immediately conveys knowledge or information about the qualities, characteristics, or features of the goods on which it is used or intended to be used. On the other hand a term which is suggestive is registerable. A

to amend under Fed. R. Civ. P. 15(b) is granted.

suggestive term is one which suggests, rather than describes, such that imagination, thought or perception is required to reach a conclusion on the nature of the goods. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The test for determining whether a term is deceptively misdescriptive as applied to the goods involves a two-part determination of (1) whether the matter sought to be registered misdescribes the goods, and (2) whether anyone is likely to believe the misrepresentation. See *In re Quady Winery, Inc.*, 221 USPQ 1213 (TTAB 1984).

Opposer bears the burden of proving, by a preponderance of the evidence, its asserted grounds of mere descriptive or alternatively, deceptive misdescriptiveness. See *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989). On this record we cannot find that opposer has met its burden.

Among the documents submitted as evidence under the parties' stipulation are, *inter alia*, the following: each party's advertisements appearing in magazines (e.g., applicant's in "The Highland Park Bagpipe," and opposer's in "Los Angeles"); a photocopy of opposer's brochure; a

photocopy of applicant's brochure; opposer's search report by a private company of the mark AQUA DAY SPA for a health and beauty spa; numerous third-party registrations including the word AQUA; and photocopies of several brochures from numerous resorts/spas (e.g., The Lodge at Sky Londa, Ihilani Spa, The Centre for Well-Being, The Spa at Doral, The Spa at the Vail Athletic Club Hotel & Spa, Fisher Island Club Spa, Canyon Ranch Spa Club at The Venetian, The Oaks at Ojai, Westglow Spa, Merv Griffin's Resort Hotel & Givenchy Spa, La Costa Resort and Spa, The Greenbrier, Elizabeth Arden Red Door Salon & Spa, and the Avon Centre Spa Salon and Store).

The Webster's Ninth New Collegiate Dictionary definitions were set forth by the parties within their stipulation as follows:

aqua 1: WATER: esp.: an aqueous solution (as of a volatile substance)
2: a light greenish blue color; and

spa 1 **a**: a mineral spring, **b**: a resort with mineral springs 2: A fashionable resort or hotel 3: *NewEng*: SODA FOUNTAIN 4: a commercial establishment with facilities for exercising and bathing.

In addition, we take judicial notice of the following definition of "aqua" from The Random House

Dictionary of the English Language (Second edition,
Unabridged, 1987):

--n. 1. Chiefly Pharm. a. water. b. a
liquid. c. a solution, esp. in water.
2. a light greenish-blue color. --
adj. 3. having the color aqua.

The brochures of various third-party spas clearly indicate that water is an important aspect of certain of the services which spas offer to their customers. For example, the terms "hydrotherapy," "hydration," "bath," "whirlpool," "shower," and "pool" appear in many of the brochures. Further, these brochures also clearly include various uses of the word "aqua," for example, "Aqua Aerobics," "Aqua Exercise," "Aqua Interval," "Aquacizer," "Aqua Flex," and "Aqua Combo." These uses of "aqua" from opposer's evidence are generally use as an adjective, whereas "aqua" as a noun conveys the impression of a product.

Moreover, the fact that water is used in certain spa services (either specifically applicant's services or spa services generally), and the fact that several spas use the term "Aqua" within their brochures do not prove that the term "AQUA" is merely descriptive or deceptively misdescriptive of "health spa and beauty salon services." All establishments use water, at least for cleaning purposes, which does not make the term "AQUA" merely

descriptive of all services, e.g., hotel services, restaurant services.

Even though water is utilized in some of the services offered by a spa, applicant has not applied to register the term "water" or the term "spa." The evidence shows these three separate words are distinct, with different commercial impressions, "spa" connoting a spring or a resort, "water" connoting the clear, colorless liquid necessary to sustain life, whereas "aqua" may connote water, or a bluish green color, or a pharmaceutical term relating to a liquid solution.

Our primary reviewing court, the Court of Appeals for the Federal Circuit, has made clear that descriptiveness issues generally cannot be determined on the basis of analogies drawn from terms other than the term that is sought to be registered. See *In re Seats, Inc.*, 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985). See also, *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha*, 228 USPQ 672 (TTAB 1985). That is, even if the words "aqua" and "water" and "spa" are related, we cannot focus on the related terms, rather, we must focus on the applied-for term itself. Moreover, by far the majority of the

evidence showing third-party uses of the term "AQUA" is ambiguous--some even appearing to be trademark uses, while others may be seen as descriptive uses.

Because it requires a multi-staged reasoning process to reach opposer's conclusion that "AQUA" is merely descriptive of health spa and beauty salon services, the term does not immediately and forthwith convey information about a significant component of the involved services. In addition, it is clear that while the term "aqua" is defined as "water," it is also defined as a color and as a liquid solution, presumably these definitions being common meanings of the term, all easily understood by the purchasing public, making the term suggestive, not merely descriptive of applicant's involved services. See *In re The Registry Hotel Corporation*, 216 USPQ 1104 (TTAB 1983); and *In re Universal water Systems, Inc.*, 209 USPQ 165 (TTAB 1980).

Finally, opposer relies heavily on the cases of *In re Ralston Purina Company*, 145 USPQ 575 (TTAB 1965); and *In re Pencils Inc*, 9 USPQ2d 1410 (TTAB 1988). We find both of these cases distinguishable from the situation now before us. First, of course, both of those cases were ex parte appeals, not inter partes opposition or cancellation proceedings. Further, with regard to the

Ralston Purina case, the applied-for term "bite-size" (held merely descriptive for breakfast cereal) appeared on applicant's specimens in the phrase "bite-size shredded wheat" which, in turn, appeared under the mark "WHEAT CHEX," and applicant therein admitted that others used the term in a merely descriptive sense, but unsuccessfully argued both that its product was smaller than "bite-size" and that the term had acquired distinctiveness. With regard to the Pencils case, ("pencils" and design held merely descriptive of retail stationery and office supply services) a customer of a stationery/office supply store would use the term "pencil" to identify a specific product he or she wished to purchase at the store, but the record before us does not show that customers of a health spa and beauty salon identify their desire to obtain an "aqua."

Based on the sparse and unconvincing record before us, we conclude that AQUA is suggestive rather than merely descriptive of applicant's services.

Although opposer argued that the term "Aqua" is deceptively misdescriptive, there is no evidence that the term misdescribes health spa and beauty salon services, nor is there any evidence that anyone would likely believe such a misrepresentation (if opposer has

Opposition No. 116582

established there was a misrepresentation). Simply put, this record does not establish that the term "AQUA" is deceptively misdescriptive of health spa and beauty salon services.

Decision: The opposition is dismissed.